



RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2178
Docket No.: 1075.1167

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Satoshi IWATA et al.

Serial No. 09/862,448

Group Art Unit: 2178

Confirmation No. 8881

Filed: May 23, 2001

Examiner: Campbell, Joshua D.

For: DISPLAY APPARATUS, AND COMPUTER-READABLE RECORDING MEDIUM IN
WHICH DISPLAY CONTROL PROGRAM IS RECORDED

PRE-APPEAL BRIEF CONFERENCE REQUEST

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the following reasons:

A. Cited prior art does not teach all the features recited in the independent claims

Claims 1, 5-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,801,713 to Endo et al. (hereinafter "Endo") in view of U.S. Patent No. 6,002,798 to Palmer et al. ("Palmer").

Independent claim 1 was amended on April 9, 2007 to specify that among the automatic paging display modes there is "a partially displaying mode in which a portion of each page is displayed, the displayed portion being extracted according to a predetermined condition."

Applicants argued that the cited prior art references, Enzo and Palmer, alone or in combination, do not teach or suggest at least the partially displaying mode as recited in claim 1. The Office Action fails to respond to the argument and repeats verbatim the rejection set forth in the Office

Action mailed on December 12, 2006, before the claim was amended. Claim 1 is patentable at least because the cited prior art does not render obvious the partially displaying mode.

Dependent claims 5-12 are also patentable by inheriting patentable features from independent claim 1 and by reciting additional patentable features. For example, claim 5 specifies that the predetermined condition, which according to claim 1 is used in the partially displaying mode to extract the displayed portion, involves a font size. Palmer discloses nine levels of abstractions in displaying pages of a document, but none of the nine levels display only a portion of the page and none of the nine levels displays based on a condition related to the font size (or type as specified in claim 6).

The Office Action also fails to make a prima facie case of obviousness relative to claim 13. Claim 13 patentably distinguishes over the cited prior art at least by reciting "a partially displaying mode in which a portion of each page is displayed, the displayed portion being extracted according to a predetermined condition."

Dependent claims 17-20 depending from claim 13 are patentable due to the cited prior art references' failure to teach or suggest all the elements of claim 13, but also by reciting additional patentable features. For example, Enzo and Palmer, alone or in combination do not teach or suggest "[displaying] partially each page by extracting only an image from each page and displaying said extracted image on said displaying section," as recited in claim 19.

Independent claim 21 is patentable at least because the cited prior art fails to teach or suggest at least "a partially displaying mode in which each page is displayed partially, by extracting and displaying a page portion according to a predetermined condition."

Dependent claims 22 and 23 are also patentable by inheriting patentable features from claim 21, and by reciting additional patentable features. For example, relative to claim 22, Enzo and Palmer, alone or in combination do not render obvious the predetermined condition used to extract a page portion as being "one of text having a predetermined font size, text having a predetermined font type, and an image."

B. There is no reason to combine the teachings of the prior art references

In response to the Applicants' argument relative to the lack of motivation to combine, the Examiner indicates col. 8, lines 15-31 of Palmer as providing the rationale for the combination (see Page 7 item 7 of the final Office Action mailed on June 13, 2007). The indicated paragraph of Palmer allegedly supports the statement that Enzo and Palmer teachings "allow for rapid browsing of documents." However, the indicated portion of Palmer does not teach or suggest

combining the "browsing mode" disclosed therein for rapid browsing of documents, with a manual or an automatic scrolling mode taught by Enzo. Although the Examiner admits that an obviousness rejection has to include a teaching, suggestion, or motivation, he fails to deliver anything more than a statement of the benefits already achieved in Palmer. In the recent decision *KSR Int'l. v. Teleflex* (2007), the Supreme Court reiterated that the Examiner must establish "an apparent reason to combine ... known elements." (KSR Opinion at page 4). Merely stating the advantage of the elements in one reference does not support combining its teachings with teachings of another reference. Therefore, Applicants respectfully submit that the combination of the teachings in Enzo and Palmer is based on impermissible hindsight.

CONCLUSION

The proposed combination of references relied upon in rejecting the claims under 35 U.S.C. §103 does not teach or suggest every element of the claims. Further, a valid line of reasoning from the prior art providing a suggestion or motivation to combine the references has not been presented. Accordingly, the Applicants respectfully submit that the Examiner's rejections are clearly without basis and should be withdrawn. Further, the Applicants respectfully request that the Office issue a finding that the application is allowed on the existing claims and that prosecution remains closed.

Respectfully submitted,

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